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EXAMINER

BEHULU, ALEMAYEHU

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,250

Applicant(s)

GIOSCIA ET AL.

Examiner

Alemayehu Behulu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☒ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Specification

1. Claims 31-34 are objected to because of the following informalities: Regarding claims 31-34, they improperly depend on claim 1 as opposed to depending on claim 30. The office treated claims 31-34 as dependent of claim 30.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 8-10, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ditzik (U.S. Patent No. 5, 983, 073).

Regarding claim 1, Ditzik discloses a system of electronic devices (figures 2 and 7) comprising: a first device residing in a first housing (figures 2 and 3, number 14), said first device comprising a microphone (figure 3, number 14C, column 5, lines 52-55, column 8, lines 29-35) and a speaker (figure 3, number 14A, column 5, lines 52-55, column 8, lines 29-35); and a second device residing in a second housing (figure 2, number 2), said second device comprising a processor (figure 7, number 38, 48), a memory unit coupled to said processor (figure 7, number 42), electronics for wireless communications coupled to said processor (figure 7, number 54), and a first display

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coupled to said processor (figure 7, number 44), said second housing comprising a means for coupling said first device to said second device (figure 2, number 8, column 5, lines 52-53 and 59-67) ; wherein said first device is communicatively coupled by a wireless connection to said second device (column 5, lines 49-52) and wherein said first device and said second device work in combination to provide the capability for wireless communications with one or more other devices (column 6, lines 7-12 and lines 33-45).

Regarding claim 3, Ditzik discloses the system as recited in claim 1 wherein said first device further comprises a control element (figure 2, number 14, column 5, lines 55-59, column 6, lines 16-19).

Regarding claims 8 and 9, Ditzik discloses the system as recited in claim 3 wherein said control element is operable to activate and to terminate said wireless communication (see figure 2, number 14, column 5, lines 55-59, column 6, lines 6-19, note: it is well known in the art that this type of handsets can initiate/activate and terminate wireless communication).

Regarding claim 10, Ditzik discloses the system as recited in claim 1 wherein said first device further comprises a Bluetooth-enabled transceiver and said second device further comprises a Bluetooth-enabled transceiver (see column 5, lines 49-52, column 6, lines 37-45, note: the office interprets that IR is used as bluetooth communication between the first device figure 1, number 14 and second device figure 1, number 2).

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Regarding claim 13, Ditzik discloses the system as recited in claim 1 wherein said means for coupling said first device to said second device is a receiving slot (column 5, lines 59-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 4, 15-19, 23, 24, 27, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ditzik (U.S. Patent No. 5, 983, 073) in view of Lehtonen (U.S. Patent No. 6, 014, 573).

Regarding claim 2, Ditzik discloses the system as recited in claim 1. However, Ditzik fails to disclose explicitly that first device further comprises a second display. But, Lehtonen discloses device further comprises a display (figure 1, number 1b). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) with Lehtonen (U.S. Patent No. 6, 014, 573) so that the user of the device has the ability to monitor the first device capability, such as battery and signal level.

Regarding claims 4 and 19, Ditzik discloses the system as recited in claims 3 and 15 respectively. However, Ditzik fail to disclose control element is operable to control the

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volume of said speaker. But, Lehtonen discloses control element is operable to control the volume of said speaker (figure 1, number 3, column 4, lines 26-32, lines 47-57).

Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) with Lehtonen (U.S. Patent No. 6, 014, 573) because it allows the user to adjust the volume depending to the environment of his/her surrounding during the call and to make hands-free conversation during the incoming and outgoing calls.

Regarding claim 15, Ditzik discloses a system of electronic devices comprising: a first device residing in a first housing (see Ditzik figures 1 and 3, number 14), said first device comprising a microphone (see Ditzik, figure 3, number 14C, column 5, lines 52-55, column 8, lines 29-35), a speaker (see Ditzik figure 3, number 14A, column 5, lines 52-55, column 8, lines 29-35), and a control element (see Ditzik figure 2, number 14, column 5, lines 55-59, column 6, lines 16-19); and a personal digital assistant residing in a second housing (see Ditzik column 2, lines 57-65, column 3, lines 50-56 figures 1-4, number 2), said personal digital assistant comprising a processor (see Ditzik figure 7, numbers 38, 48), a memory unit coupled to said processor (see Ditzik figure 7, number 42), electronics for wireless communications coupled to said processor (see Ditzik figure 7, numbers 54, 51), a display coupled to said processor (see Ditzik figure 7, number 44), a handwriting recognition pad coupled to said processor (figure 7, number 9), and a cursor control device (see Ditzik figure 7, number 56), said second housing comprising a means for coupling said first device to said second device (see Ditzik figure 2, number 8, column 5, lines 52-53 and 59-67); wherein said first device is communicatively coupled

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to said personal digital assistant (see Ditzik figure 2, number 26, column 5, lines 47-52) and wherein said first device and said personal digital assistant work in combination to provide the capability for wireless communications with one or more other devices(column 6, lines 7-12 and lines 33-45). However, Ditzik fails to disclose a first display. But, Lehtonen discloses (see Lehtonen figure 1, number 1b). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) with Lehtonen (U.S. Patent No. 6, 014, 573) so that the user of the device has the ability to monitor the first device capability, such as battery and signal level.

Regarding claim 16, the combination of Ditzik and Lehtonen disclose the system as recited in claim 15 wherein said first device and said personal digital assistant are communicatively coupled by a wireless connection (see Ditzik column 5, lines 49-52).

Regarding claim 17, the combination of Ditzik and Lehtonen disclose the system as recited in claim 16 wherein said first device further comprises a Bluetooth-enabled transceiver and said personal digital assistant further comprises a Bluetooth-enabled transceiver (see Ditzik column 5, lines 49-52, column 6, lines 37-45, note: the office interprets that IR is used as bluetooth communication between the first device figure 1, number 14 and second device figure 1, number 2).

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Regarding claim 18, the combination of Ditzik and Lehtonen disclose the system as recited in claim 15 wherein said control element is operable to control the volume of said speaker (see Ditzik figure 2, number 26, column 5, 47-52).

Regarding claims 23 and 24, the combination of Ditzik and Lehtonen disclose the system as recited in claim 3 wherein said control element is operable to activate and to terminate said wireless communication (see Ditzik figure 2, number 14, column 5, lines 55-59, column 6, lines 6-19, note: it is well known in the art that this type of handsets can initiate/activate and terminate wireless communication).

Regarding claim 27, the combination of Ditzik and Lehtonen disclose the system as recited in claim 15 wherein said means for coupling said first device to said second device is a receiving slot (see Ditzik column 5, lines 59-65).

Regarding claim 29, all the limitations are listed in claim 15 above except for a bluetooth transceiver (see Ditzik see column 5, lines 49-52, column 6, lines 37-45, note: the office interprets that IR is used to enable bluetooth transceiver).

4. Claims 5, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ditzik (U.S. Patent No. 5, 983, 073) and Lehtonen (U.S. Patent No. 6, 014, 573) as applied to claims 4 and 19 above, and further in view of Ekel (U.S. Pub. No. 2002/0002707).

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Regarding claims 5 and 20, the combination of Ditzik and Lehtonen disclose the system as recited in claims 4 and 19 respectively wherein said first device further comprises a second display (see Lehtonen figure 1, number 1b) and first display (see Ditzik figure 2, number 4). However, Ditzik and Lehtonen fail to disclose where information regarding said volume is displayed on said first display. But, Ekel discloses information regarding said volume is displayed on said first display (paragraphs [0041]-[0043], figures 1 and 4). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) and Lehtonen (U.S. Patent No. 6, 014, 573) with Ekel (U.S. Pub. No. 2002/0002707) because the user can adjust the volume from a distance, for example when giving computer-based presentation as suggested by Ekel.

5. Claims 6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ditzik (U.S. Patent No. 5, 983, 073) in view of Erikson (U.S. Patent No. 6, 622, 018).

Regarding claim 6, Ditzik discloses the system as recited in claims 3. However, Ditzik fails to disclose wherein said control element is operable to allow access to database information located in said memory unit. But, Erikson discloses control element is operable to allow access to database information located in said memory unit (column 8, lines 42-65, column 6, lines 17-19, figures 5, 6). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S.

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Patent No. 5, 983, 073) with Erikson (U.S. Patent No. 6, 622, 018) so that the user can download programs from local database easily to execute applications.

Regarding claim 7, the combination of Ditzik and Erikson disclose the system as recited in claims 6 wherein said first device further comprises a second display wherein said database information is displayed on said first display (see Erikson column 8, lines 47-55, column 9, lines 3-17, figure 7).

6. Claims 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ditzik (U.S. Patent No. 5, 983, 073) and Lehtonen (U.S. Patent No. 6, 014, 573) as applied to claim 15 above, and further in view of Erikson (U.S. Patent No. 6, 622, 018).

Regarding claim 21, the combination of Ditzik and Lehtonen disclose the system as recited in claim 15. However, Ditzik and Lehtonen fail to disclose wherein said control element is operable to allow access to database information located in said memory unit. But, Erikson discloses control element is operable to allow access to database information located in said memory unit (column 8, lines 42-65, column 6, lines 17-19, figures 5, 6). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) and Lehtonen (U.S. Patent No. 6, 014, 573) with Erikson (U.S. Patent No. 6, 622, 018) so that the user can download programs from local database easily to execute applications. wherein said control element is operable to allow access to database information located in said memory unit.

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Regarding claim 22, the combination of Ditzik, Lehtonen and Erikson disclose the system as recited in claim 21 wherein said database information is displayed on said first display (see Erikson column 8, lines 47-55, column 9, lines 3-17, figure 7).

7. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ditzik (U.S. Patent No. 5, 983, 073) in view of Mault (U.S. Pub. No. 2003/0208113).

Regarding claims 11 and 12, Ditzik discloses the system as recited in claim 3. However, Ditzik fails to disclose wherein said control element is a button and jog dial. But, Mault discloses wherein said control element is a button (paragraphs [0101], [0121]) and jog dial (paragraphs [0109] and [0121]). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) with Mault (U.S. Pub. No. 2003/0208113) so that the user can make a dial without punching each numbers on the keypad.

8. Claims 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ditzik (U.S. Patent No. 5, 983, 073) and Lehtonen (U.S. Patent No. 6, 014, 573) as applied to claim 15 above, and further in view of Mault (U.S. Pub. No. 2003/0208113).

Regarding claims 25 and 26, Ditzik and Lehtonen disclose the system as recited in claim 15. However, Ditzik and Lehtonen fail to disclose wherein said control element is a

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button and jog dial. But, Mault discloses wherein said control element is a button (paragraphs [0101], [0121]) and jog dial (paragraphs [0109] and [0121]). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) and Lehtonen (U.S. Patent No. 6, 014, 573) with Mault (U.S. Pub. No. 2003/0208113) so that the user can make a dial without punching each numbers on the keypad.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ditzik (U.S. Patent No. 5, 983, 073) in view of Hamano (U.S. Pub. No. 2002/0166127).

Regarding claim 14, Ditzik discloses the system as recited in claim 1. However, Ditzik fails to disclose means for coupling said first device to said second device is a magnet. But, Hamano discloses means for coupling said first device to said second device is a magnet (paragraphs [0024], [0061], figure 7). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) with Hamano (U.S. Pub. No. 2002/0166127) in order to locate the device conveniently and not to lose it.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ditzik (U.S. Patent No. 5, 983, 073) and Lehtonen (U.S. Patent No. 6, 014, 573) as applied to claim 15 above, and further in view of Hamano (U.S. Pub. No. 2002/0166127).

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Regarding claim 28, Ditzik and Lehtonen disclose the system as recited in claim 15.

However, Ditzik and Lehtonen fail to disclose means for coupling said first device to said second device is a magnet. But, Hamano discloses means for coupling said first device to said second device is a magnet (paragraphs [0024], [0061], figure 7). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) and Lehtonen (U.S. Patent No. 6, 014, 573) with Hamano (U.S. Pub. No. 2002/0166127) in order to locate the device conveniently and not to lose it.

11. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ditzik (U.S. Patent No. 5, 983, 073) in view of Smith (U.S. Patent No. 6, 333, 973).

Regarding claim 30, Ditzik discloses a portable electronics device (figure 2) comprising:

a) a portable computer system comprising (figure 2, number 2 and figure 7): a processor coupled to a bus (figure 7, number 38, 48, 60); a memory coupled to said bus for containing database applications and database information (figure 7, number 42, 60); a display unit coupled to said bus for displaying portions of said database information (figure 7, number 44); a first wireless transceiver unit coupled to said bus (figure 7, number 32, 54, 51, 60); a wireless telephone communications device (figures 2, 7, number 14); and b) a communication device irremovably attached to said portable computer system (figure 2, 7, number 14, column 5, lines 52-53, column lines 59-64) and comprising: a second wireless transceiver for communicating with said first wireless transceiver (column 5, lines 49-55, see figure 2, number 14 antenna out of number 14,

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figure 7, the line from number 32 to the antenna of number 14); microphone (figure 3, number 14C, column 5, lines 52-55, column 8, lines 29-35); a speaker (figure 3, number 14A, column 5, lines 52-55, column 8, lines 29-35). However, Ditzik fails to disclose a second display unit for displaying a portion of said database information thereon and for facilitating an automatic dialing process, based on user input, using said wireless telephone communication device. But, Smith discloses a second display unit for displaying a portion of said database information thereon (figure 2, number 2) for facilitating an automatic dialing process, based on user input, using said wireless telephone communication device (column 11, lines 20-31). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) with Smith (U.S. Patent No. 6, 333, 973) in order to monitor the messages on the display and dial without punching numbers each time the call is made.

Regarding claim 31, the combination of Ditzik and Smith disclose portable electronic device as described in claim 30 wherein said communication device further comprises buttons for displaying different information on said second display unit in response to user control (see Smith column 9, lines 23-34, column 10, lines 18-29, column 11, lines 20-31).

Regarding claim 32, the combination of Ditzik and Smith disclose a portable electronic device as described in claim 30 wherein one of said buttons is a talk/end button for, when

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activated, causing said automatic dialing process to call a number defined by selected information within said second display (see Smith column 11, lines 20-31).

Regarding claim 33, the combination of Ditzik and Smith disclose a portable electronic device as described in claim 30 wherein said first and second wireless transceivers are Bluetooth enabled devices (see Ditzik column 5, lines 49-52, column 6, lines 37-45, note: the office interprets that IR is used to enable the transceiver for bluetooth communication).

12. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ditzik (U.S. Patent No. 5, 983, 073) and Smith (U.S. Patent No. 6, 333, 973) as applied to claim 30 above, and further in view of Lehtonen (U.S. Patent No. 6, 014, 573).

Regarding claim 34, the combination of Ditzik and Smith disclose a portable electronic device as described in claim 30 wherein said communications device has a length dimension that is substantially the same as a length dimension of said portable computer system. However, Ditzik and Smith fail to disclose communications device has a length dimension that is substantially the same as a length dimension of said portable computer system. But, Lehtonen discloses communications device (figure 1, number 1) has a length dimension that is substantially the same as a length dimension of said portable computer system (figure 1, numbers 1 and 2, column 3, lines 6-20, abstract). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Ditzik (U.S. Patent No. 5, 983, 073) and Smith (U.S. Patent No. 6, 333, 973)

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with Lehtonen (U.S. Patent No. 6, 014, 573) because the user can pack and carry both devices compacted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alemayehu Behulu whose telephone number is 703-305-4828. The examiner can normally be reached on 8 AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB

Nguyen VO
4-19-2004

**NGUYENT.VO
PRIMARY EXAMINER**